

### **REMARKS**

Pursuant to the present amendment, claims 22, 30 and 31 have been amended. Claims 21-24 and 30-34 are pending in the present application. No new matter has been introduced by way of the present amendment. Reconsideration of the present application is respectfully requested.

In the Final Office Action, the Examiner objected to claim 22. Pursuant to the present amendment, claim 22 has been amended in a manner that is believed to render the Examiner's objection moot. Withdrawal of the objection as to claim 22 is respectfully requested.

In the Office Action, claims 21-24 and 30-34 were rejected under 35 U.S.C. § 103 as allegedly being unpatentable over Rose in view of Fuchs (DE 20022306) or Hassler (U.S. Patent No. 6,997,958). Applicants respectfully traverse the Examiner's rejections.

In making the rejections set forth in the Final Office Action, it is respectfully submitted that the Examiner has failed to recognize many express claim limitations set forth in the pending claims. Independent claim 21 recites, among other things, an assembly comprising a first neck and a femoral hip stem comprising a second neck having a tapered outer surface that is adapted to be positioned in the tapered, cylindrical-shaped internal bore in the first neck to thereby form a Morse taper connection. Claim 21 also recites that the first neck is adapted to extend outwardly from the femoral head in various lengths, wherein each length corresponds to the thickness of at least one of the plurality of spacers.

Independent claim 30 recites, among other things, an assembly comprising a first neck and a second neck having a tapered outer surface that is adapted to be positioned in the tapered, cylindrical-shaped internal bore in the first neck to thereby form a Morse taper connection. Claim 30 also recites that the first neck extends outwardly from the femoral head by a length that corresponds to a thickness of the at least one spacer.

Dependent claim 31 recites that the at least one spacer comprises a plurality of spacers and that the first neck extends outwardly from the femoral head by a length that corresponds to a combined thickness of the plurality of spacers.

It is respectfully submitted that all pending claims are readily allowable over the art of record. Respectfully, Rose does not disclose or suggest the structure set forth in the pending claims. For example, Rose does not disclose an assembly comprising the recited first and second necks, nor does it disclose or suggest the use of the claimed spacers to determine the length by which the first neck extends from the femoral head. In Rose, in Figure 7, it is clear that the axial positioning of the neck 6 is controlled by rotating the threaded neck 6 within the threaded bore 9. Rose states “when the screw plug 16 is loosened the head can be rotated to position the same outwardly or inwardly with respect to the shoulder 5 in accordance with requirements and then when so adjusted the stem can be locked against further rotation by a clock-wise rotation of the plug 16.” Col. 2, ll. 50-55 (emphasis added). This is in direct contrast to the inventions set forth in the pending claims wherein the thickness of the one or more spacers controls the axial positioning or length of the first neck relative to the femoral head. As understood by the undersigned, the stop rings in Figure 5 of Rose do not operate to control the axial positioning of the neck 6. In fact, Rose only states that these stop rings “prevent relative displacement between the parts.” Col. 2, ll. 41-42. It is clear that the neck 6 in Figure 5, with the slot 11 formed therein, may be axially positioned within the head by loosening the plug 16 and positioning the neck 6 at the desired axial position to control the length thereof, as described for the embodiments depicted in Figures 3 and 4. Thereafter, inserting the screw 16 into the bore 15 of the neck 6 expands and binds against the bore 9 to secure the neck 6 in the desired axial position. Rose, Col. 2, ll. 7-42.

The citation to Fuchs and Hassler cannot cure the fundamental deficiencies in Rose. The Examiner asserts that the bottom opening in the figure of Fuchs is a tapered opening. The undersigned cannot tell from the drawing if that is true or not. Nevertheless, even assuming the Examiner's assertion is correct, the combination of Rose and Fuchs fails to disclose many expressly claimed features of the pending claims – namely, the use of the thickness of one or more spacers to determine the femoral offset or length of the first neck.

Hassler is similarly deficient. All Hassler discloses are purportedly new ways to make tapered connects between various components. It should also be noted that the only express disclosure of a prosthesis for a hip (Figure 10) in Hassler only shows a tapered connection between the femoral head 50 and the neck 51/tail 52 combination. Thus, the combination of Rose and Hassler likewise fails to disclose many expressly claimed features of the pending claims.

It is respectfully submitted that the assertion that the pending claims would have been obvious in view of Rose, Fuchs and Hassler is legally improper. First, even if Rose, Fuchs or Hassler were combined, that combination of art would still not teach all of the claimed limitations. Thus, such a rejection would be legally improper. Moreover, there is simply no suggestion in the art of record to modify the teachings of Rose, Fuchs and Hassler to arrive at Applicants' claimed invention.

A recent Federal Circuit case makes it crystal clear that, in an obviousness situation, the prior art must disclose each and every element of the claimed invention, and that any motivation to combine or modify the prior art must be based upon a suggestion in the prior art. *In re Lee*, 61 U.S.P.Q.2d 143 (Fed. Cir. 2002). Conclusory statements regarding common knowledge and common sense are insufficient to support a finding of obviousness. *Id.* at 1434-35. "Our case law makes clear that the best defense against the subtle but powerful attraction of hindsight-

based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references.” *Teleflex v. KSR Intern. Co.*, 119 Fed. Appx. 282 (Fed. Cir. 2005) (unpublished) (citations omitted). It is respectfully submitted that any attempt to assert that the invention defined by the amended claims submitted herein would have been obvious in view of the prior art of record constitutes an impermissible use of hindsight using Applicants’ disclosure as a roadmap.

In summary, it is believed that claims 21-24 and 30-34 are in condition for immediate allowance. The Examiner is invited to contact the undersigned attorney at (713) 934-4055 with any questions, comments or suggestions relating to the referenced patent application.

Respectfully submitted,

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